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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,339	12/05/2003	Tzu-Chiang Shih	PMXP0170USA	1338
27765	7590	10/06/2005	EXAMINER	
NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116			WILLIAMS, DON J	
			ART UNIT	PAPER NUMBER
			2878	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/707,339

Applicant(s)

SHIH ET AL.

Examiner

Don Williams

Art Unit

2878

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/05/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Victor et al (4,751,380).

As to claim 1, Victor et al disclose compatibility of a working surface (13) with an optical mouse (11), the optical mouse (11) comprise of an optical sensor (25); utilizing the optical sensor (25) to sense the optical characteristics (16, 18) of the working surface (13); utilizing a judging circuit (100) to judge the compatibility of the working surface (13) with the optical mouse (11) according to the optical characteristics (16, 18) sensed by the optical sensor (25); utilizing the judging circuit (100) to generate judging signals (A+F), (B+G), (A+C), and (D+C) according to the results obtained, (see column 2, lines 6-55, fig. 1, column 3, lines 18-67, column 4, lines 1-67, fig. 5, column 6, lines 63-68, column 7, lines 1-50).

As to claim 2, Victor et al disclose displaying the judge characteristics results (16, 18) on a display device (video terminal) or (video display) according to the judging signal, (see fig. 1, column 3, lines 67-68, column 4, lines 1-50, column 7, lines 15-50).

As to claim 3, Victor et al disclose one (LED) light-emitting device (15), (see fig. 1, column 3, lines 31-40).

As to claim 5, Victor et al disclose the display device is a monitor (video display or video terminal) of a computer system, (see column 7, lines 39-50).

As to claim 6, Victor et al disclose the judging circuit (100) is a control circuit of the optical mouse (11), (see fig. 5, column 7, lines 15-67).

As to claim 7, Victor et al disclose utilizing the optical sensor (25) to generate a sensing value, (see fig. 5, column 6, lines 63-68, column 7, lines 1-67).

As to claim 8, Victor et al disclose the judging circuit (100) is a central processing unit of a computer system, comprised of utilizing the judging circuit (100) to operate the sensing value, to judge the compatibility of the working surface (13) with the optical mouse (11), (see fig. 1, column 3, lines 18-30, fig. 5, column 6, lines 63-68, column 7, lines 1-67).

As to claim 9, Victor et al disclose an optical mouse (11) use for determining the compatibility of a working surface (13) with an optical sensor (25) for sensing the optical characteristics (16,18) of the working surface (13) to generate a sensing value (1); a judging circuit (100) is connected electrically to the optical sensor (25) for generating a judging signals (A+F), (B+G), (A+C), or (D+E) according to the sensing value (1); and a display device (video display or video terminal) electrically connected to the judging circuit for displaying the compatibility of the working surface (13) with the optical mouse (11) according to the judging signal, (see fig. 1, column 3, lines 17-67, column 4, lines 1-67, fig. 5, column 6, lines 63-68, column 7, lines 1-50).

As to claim 10, Victor et al disclose an optical mouse (11) with a judging circuit (100) is a control circuit of the optical mouse, (see fig. 5, column 7, lines 15-50).

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As to claim 11, Victor et al disclose display device is a LED (15) installed on the optical mouse (11), (see fig. 1, column 3, lines 17-67).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Victor et al.

As to claims 4 and 12, Victor et al fail to disclose wherein the display device is an LCD device. It would have been obvious for one ordinary skill in the art to use a LCD device for a display device to monitor and view the image characteristics of the working surface to determine and compare the grid patterns since they are functionally equivalent.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Don Williams whose telephone number is 571-272-8538. The examiner can normally be reached on 8:30a.m. to 5:30a.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on 571-272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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